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8/2/04**TRANSMITTAL
FORM**

(to be used for all correspondence after initial filing)

TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application No.	09/586,744	
	Filing Date	June 2, 2000	
	First Named Inventor	Harrington	
	Examiner Name	Tekchand Saidha	
	Group Art Unit	1652	
Total Number of Pages in This Submission	7	Attorney Docket No.	RI- 71904

ENCLOSURES (check all that apply)

<input checked="" type="checkbox"/> Deposit Account Authorization 50-2319	<input type="checkbox"/> Assignment Papers (for an Application)	<input type="checkbox"/> After Allowance Communication to Group
<input checked="" type="checkbox"/> Fee Attached	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Amendment / Reply	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	Petition Under 37 CFR § 1.181 To Expunge An Improperly Entered Third Party Protest	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Power of Attorney, Revocation, Change of Correspondence Address	<input checked="" type="checkbox"/> Return Postcard
<input checked="" type="checkbox"/> Express Mail No.: EV 424 741 348 US	<input type="checkbox"/> Terminal Disclaimer	<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> Request for Refund	Check for \$130.00
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> CD, No. of CD(s) _____	
<input type="checkbox"/> Response to Missing Parts/ Incomplete Application	Remarks	
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53		

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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Birgit Millauer, Reg. NO. 43,341 DORSEY & WHITNEY LLP 4 Embarcadero Center, Suite 3400 San Francisco, CA 94111 Telephone: 415 781 1989	Customer Number 32940
Signature		
Date	October 5, 2004	

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as Express Mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this date: <u>October 5, 2004</u>		
Typed or printed name	Judi Stillwell	
Signature		Date October 5, 2004

PATENT



Attorney Docket No. RI- 71904

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Harrington et al.

Examiner: Tekchand Saidha

Serial No. 09/586,744

Art Unit: 1652

Filed: June 2, 2000

Confirmation No. 7865

Title: MAMMALIAN FLAP-SPECIFIC ENDONUCLEASE

OCT 18 2004

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ATTN: DIRECTOR BRUCE KISLIUK
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION UNDER 37 CFR § 1.181 TO EXPUNGE AN IMPROPERLY ENTERED THIRD PARTY PROTEST

As set forth herein, Petitioner requests that the Third Protest submitted on August 13, 2004 against the captioned reissue application be expunged from the record, as its submission and entry was in clear violation of the rules of practice.¹ Specifically, 37 CFR 1.291(c) explicitly provides that the limited involvement of a member of the public ends with the filing of a protest, and no further submission on behalf of the protestor will be considered, unless the submission raises new issues which could not have been presented earlier. The Third Protest does not raise such new issues.

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¹ As noted in Petitioner's Response to the Second Protest, also the Second Protest was improperly entered into the record. To the extent it is still possible, Petitioner request that also the Second Protest be expunged from the record.

The Petitioner also requests issuance of a new final Office Action because the Action mailed on September 2, 2004 improperly adopts arguments and views set forth in the Third Protest.

II. STATEMENT OF FACTS

The captioned reissue application was filed on June 6, 2000 based on U.S. Patent Number 5,874,283, issued February 23, 1999. To date, three Third Party Protests have been filed: the first on January 3, 2001, a second on January 9, 2002, and a third on August 13, 2004. Each of the protests was filed by the same third party,² and each has been entered into the record and considered by the Examiner. Petitioner submitted a Response to the First Protest on February 14, 2001, rebutting its merits. A Response to the Second Protest stating that it was improperly entered, and pointing out its lack of merit, was filed on May 22, 2002.

The Third Protest, filed August 13, 2004, raises five (5) issues that allegedly could not have been addressed in the First or Second Protests. Despite an abject lack of merit in the Protester's reasoning, this third Protest was entered into the record and its arguments considered and adopted by the Examiner in the final Office Action mailed September 2, 2004. This is evidenced by the fact that the positions taken in the final Office Action are inconsistent with the Office's Interview Summary of April 27, 2004 (attached hereto as Exhibit 1).

III. ARGUMENT

A. The Third Protest Should Be Expunged From The Record

The Protestor alleges that the Third Protest raises issues that could not have been addressed in the first or second protests. The MPEP makes abundantly clear that protests submitted to respond

² Although the Protester is not identified on any of the protests, each was filed by the same law firm, and the latter two are labeled "Second Protest" and "Third Protest." Moreover, the Third Protest attaches as an Exhibit a copy of the Second Protest.

to arguments and amendments presented by an applicant during *ex parte* prosecution are *improper and will not be entered into the application file*:

Protests which will not be entered in the application file include those further submissions in violation of CFR §1.291(c) by which protester merely seeks to participate in the examination process. ***For example, mere arguments relating to an Office action or an applicant's reply would not qualify as a new protest.*** Likewise, additional comments seeking to bring in further or even new data or information with respect to an issue previously raised by protestor would not qualify as a new protest. The Office will not add these arguments or comments to the original protest and will not enter them in the application file.

MPEP §1901.03 (emphasis added). By the Protestor's own admission, their Third Protest does not raise new issues. It merely responds to arguments and amendments made by the Petitioner:

The present communication addresses five new issues *based on the Applicant's arguments to the patent office....*"

Third Protest at page 3 (emphasis supplied). Thus, by the Protestor's own admission, its Third Protest violates the rules of practice and should not have been entered into the record.

The Protestor's serial submissions are nothing more than a transparent attempt by an admitted adversary to participate in, and prolong, the examination process. However, as clearly stated by the MPEP, examination of an application is an *ex parte* process conducted between an applicant and the Patent Office, acting on behalf of the public:

The question of whether or not a patent will issue is a matter between the applicant and the Office *acting on behalf of the public*.

MPEP §1901 (emphasis supplied). There is no room for *inter parte* advocacy. Members of the public have an advocate-- it is the Patent Office.

The rules regulating third party protests fully contemplated the manifest unfairness and disruptive effect that permitting adversarial members of the public to participate *inter partes* in the

examination process would have on an applicant by explicitly prohibiting the entry of sequential protests that do not raise new issues. Since the Third Protest does nothing more than respond to arguments and amendments made by the Petitioner, the letter of the rules, as well as notions of fair play, dictate that it be expunged from the prosecution history of the instant reissue application.

B. A New Final Office Action Should Be Issued That Considers The Issues Objectively And Untainted By Arguments Advocated By An Interested Third Party

Petitioner also requests issuance of a new final Office Action to supercede the Action mailed September 2, 2004. The pending Action was prepared after entry and consideration of the arguments presented in the Third Protest, and clearly adopts positions taken by the (adversarial) Protester. For the reasons discussed above, Petitioner submits it has been unduly prejudiced. The issue is not whether the remarks in the Third Protest have merit (which Petitioner has already demonstrated it has not), rather, the issue is that it is duplicative and disruptive. The Third Protest was prepared by an adversary and should not have been entered. Petitioner should not have to respond.

V. CONCLUSION

In view of the foregoing, Petitioner submits that the Director should act to expunge the Third Protest (as possibly the Second Protest) from the record. In addition, a new final Office Action should be issued, untainted by an interested third party's views.

Submitted herewith is the required fee. Petitioner believes that no other fees are due, however, should the Commissioner determine otherwise, he is authorized to charge additional fees, including extension fees, or credit any overpayment, to Deposit Account No. 50-2319 (Our Order No. 470438-00007).

Please direct any telephone calls concerning this application to the undersigned attorney at
(415) 781-1989.

Respectfully submitted,

DORSEY & WHITNEY LLP

Dated: October 5, 2004

By: 

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